

ESTTA Tracking number: **ESTTA773999**

Filing date: **09/30/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	Medical University of South Carolina		
Entity	State Agency	Citizenship	South Carolina
Address	135 Cannon Street, Suite 402 Charleston, SC 29425 UNITED STATES		

Attorney information	John C. McElwaine Nelson Mullins Riley & Scarborough LLP 100 North Tryon Street 42nd Floor, IP Department Charlotte, NC 28202 UNITED STATES ip@nelsonmullins.com, john.mcelwaine@nelsonmullins.com Phone:843-720-4302
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### Registrations Subject to Cancellation

Registration No	4735990	Registration date	05/12/2015
Registrant	The University of Utah 2000 Circle of Hope Salt Lake City, UT 84112 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 036. First Use: 2014/04/30 First Use In Commerce: 2014/04/30  
All goods and services in the class are cancelled, namely: Charitable fundraising services for cancer research and treatment

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)		
No use of mark in commerce before application, amendment to allege use, or statement of use was filed	Trademark Act Sections 14(1) and 1(a), (c), and (d)		
Abandonment	Trademark Act Section 14(3)		
Registrant not rightful owner of mark for identified goods or services	Trademark Act Sections 14(1) and 1		
Registration No	4633651	Registration date	11/04/2014
Registrant	The University of Utah 2000 Circle of Hope Salt Lake City, UT 84112 UNITED STATES		


## Goods/Services Subject to Cancellation

Class 036. First Use: 2014/08/11 First Use In Commerce: 2014/08/11  
All goods and services in the class are cancelled, namely: Charitable fundraising services for cancer research and treatment

## Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
No use of mark in commerce before application, amendment to allege use, or statement of use was filed	Trademark Act Sections 14(1) and 1(a), (c), and (d)
Abandonment	Trademark Act Section 14(3)
Registrant not rightful owner of mark for identified goods or services	Trademark Act Sections 14(1) and 1

## Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	4003495	Application Date	04/22/2010
Registration Date	07/26/2011	Foreign Priority Date	NONE
Word Mark	CHANGING WHAT'S POSSIBLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 2010/08/16 First Use In Commerce: 2010/08/16 Educational services, namely, providing courses of instruction and training at the undergraduate, graduate and professional level in the fields of medicine, nursing, health sciences, biomedical sciences, dental medicine, health administration, rehabilitation sciences, physical therapy, biochemistry, molecular biology, pharmaceutical sciences, pharmacology, environmental health sciences, marine biosciences, microbiology, immunology, biometry, epidemiology, and medical humanities</p> <p>Class 042. First use: First Use: 2010/08/16 First Use In Commerce: 2010/08/16 Medical and pharmaceutical research; medical and scientific research, namely, conducting clinical trials</p> <p>Class 044. First use: First Use: 2010/08/16 First Use In Commerce: 2010/08/16 Health care services, namely, hospitals, emergency care centers, primary and specialty care centers, and outpatient clinics</p>		

Attachments	85020241#TMSN.png( bytes ) 20160930142629146.pdf(1683974 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John C. McElwaine/
Name	John C. McElwaine
Date	09/30/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Medical University of South Carolina,	)	Cancellation No.: _____
	)	
Petitioner,	)	Registration No. 4735990
	)	Mark: WHAT'S POSSIBLE
v.	)	
	)	Registration No. 4633651
University of Utah,	)	Mark: IMAGINING WHAT'S POSSIBLE
	)	
Registrant.	)	
_____	)	

**PETITION TO CANCEL**

The Medical University of South Carolina, an agency of the State of South Carolina ("Petitioner"), having an address of 135 Cannon Street, Suite 402, Charleston, South Carolina 29425, hereby petitions to cancel U.S. Registration No. 4633651 for the mark IMAGINING WHAT'S POSSIBLE reciting "[c]haritable fundraising services for cancer research and treatment" (the "'651 Registration") and U.S. Registration No. 4735990 for the mark WHAT'S POSSIBLE reciting "[c]haritable fundraising services for cancer research and treatment" (the "'990 Registration"), both owned by the University of Utah ("Registrant"), a body politic and corporate of the state of Utah, with an address of 2000 Circle of Hope, Salt Lake City, Utah 84112.

Petitioner states the following grounds in support of cancellation:

**THE PARTIES**

1. Since 1824, Petitioner has served the citizens of South Carolina in the fields of research, health care and education. In the more than ninety years since Petitioner became a state institution, Petitioner has grown to become one of the nation's top academic

health science centers, with a 700-bed medical center and six colleges that train approximately 2,600 health care professionals per year.

2. Registrant is a state university formed by the state of Utah. Upon information and belief, the marks in the '651 Registration and in the '990 Registration were allegedly to be used, not directly by the Registrant, but a third party entity.

3. On April 13, 2014, Petitioner filed Application Serial No. 86/645106 to register the mark IMAGINE WHAT'S POSSIBLE. Petitioner's application was refused registration in a first Office Action dated September 15, 2015. As grounds for refusal, the Examining Attorney indicated that there was likely to be confusion, under Section 2(d) of the Lanham Act, between Petitioner's application and the services recited several registrations owned by Registrant.

4. On March 30, 2016, a final Office Action was issued that maintained the refusal under Section 2(d) of the Lanham Act based upon the marks in the '651 Registration and the '990 Registration. *See Exhibit A* containing the TSDR Record Printout for this application and office action.

#### **CANCELLATION BASED UPON A LIKELIHOOD OF CONFUSION**

5. In 2010, to represent its ongoing mission to provide excellence in patient care, teaching and research, Petitioner adopted the mark, "CHANGING WHAT'S POSSIBLE."

6. Petitioner is the owner of a federal trademark registration, U.S. Reg. No. 4003495, filed on April 22, 2010, for the mark **CHANGING WHAT'S POSSIBLE** for "Educational services, namely, providing courses of instruction and training at the undergraduate, graduate and professional level in the fields of medicine, nursing, health sciences, biomedical sciences, dental medicine, health administration, rehabilitation sciences, physical

therapy, biochemistry, molecular biology, pharmaceutical sciences, pharmacology, environmental health sciences, marine biosciences, microbiology, immunology, biometry, epidemiology, and medical humanities (class 41); Medical and pharmaceutical research; medical and scientific research, namely, conducting clinical trials (class 42); and Health care services, namely, hospitals, emergency care centers, primary and specialty care centers, and outpatient clinics (class 44)." *See Exhibit B* containing the TSDR Record Printout for this registration.

7. Petitioner's trademark registration provides it with *prima facie* exclusive right to use the mark for the services listed therein.

8. The application that matured into the '990 Registration was filed on August 13, 2013 for the mark WHAT'S POSSIBLE reciting "[c]haritable fundraising services for cancer research and treatment". The '990 Registration was issued on May 12, 2015.

9. The application that matured into the '651 Registration was filed on August 13, 2013 for the mark IMAGINING WHAT'S POSSIBLE reciting "[c]haritable fundraising services for cancer research and treatment". The '651 Registration was issued on November 4, 2014.

10. Petitioner's trademark registration and use of the mark CHANGING WHAT'S POSSIBLE long precedes the first use and the priority date of the above-referenced registrations. Thus, there is no issue as to Petitioner's senior priority.

11. Petitioner has developed and currently possesses substantial goodwill in its CHANGING WHAT'S POSSIBLE mark.

12. The alleged marks in the '651 Registration and the '990 Registration are virtually identical to Petitioner's CHANGING WHAT'S POSSIBLE mark and its federal trademark rights.

13. The alleged marks in the '651 Registration and the '990 Registration are used in connection with services that are highly related to the services rendered in commerce by Petitioner under its mark. There is simply no question that most, if not all, medical universities and hospitals, have some form of charitable fundraising services.

14. Petitioner's services and Registrant's services are so similar as to cause a likelihood of confusion when rendered under the alleged marks in the '651 Registration and the '990 Registration.

15. The alleged marks in the '651 Registration and the '990 Registration so resembles Petitioner's CHANGING WHAT'S POSSIBLE MARK when used in connection with fundraising services as to be likely to cause confusion, or to cause mistake, or to deceive, in violation of Section 2(d) of the Lanham Act, and/or as to falsely suggest a connection with Opposer in violation of Section 2(a) of the Lanham Act.

#### **CANCELLATION BASED UPON ABANDONMENT**

16. Upon information and belief, Registrant is not currently using the marks, or has made only token use of the marks, IMAGINING WHAT'S POSSIBLE and/or WHAT'S POSSIBLE, in commerce that can be regulated by U.S. Congress, in connection with charitable fundraising services.

17. Upon information and belief, Registrant has abandoned the services recited in International Class 36 of the '651 Registration and the '990 Registration by discontinuing use of (or never having used) said marks, with no intent to resume such uses.

#### **CANCELLATION BASED UPON LACK OF BONA FIDE INTENTION**

18. Upon information and belief, at the time of filing the applications that matured into the '651 Registration and the '990 Registration, Registrant did not have a *bona fide*

intention to use the mark IMAGINING WHAT'S POSSIBLE or WHAT'S POSSIBLE, in commerce for fundraising services. Instead, it appears that these marks were related to the Huntsman Cancer Foundation, a separate Utah corporation, or another entity.

19. In the Alternative, at the time of filing the applications that matured into the '651 Registration and the '990 Registration, Registrant was not the proper owner of the marks, IMAGINING WHAT'S POSSIBLE or WHAT'S POSSIBLE, and thus, the registrations are void *ab initio*.

### STANDING

20. Petitioner will be damaged by the continued registration of the '651 Registration and the '990 Registration, for the reasons set forth above, as such registrations may interfere with Petitioner's ability to conduct its business. Furthermore, since confusion in the trade is likely, consumers may encounter Registrant's services, or advertisements therefor, believing them to be approved by, endorsed by or affiliated with Petitioner, or vice-versa. Such confusion will damage Petitioner because of injury to or dilution of its goodwill and reputation.

21. Petitioner has also been damaged because the '651 Registration and the '990 Registration have been cited against its Application Serial No. 86/645106 to register the mark IMAGINE WHAT'S POSSIBLE.

WHEREFORE, Petitioner prays U.S. Registration No. 4633651 and U.S. Registration No. 4735990 are cancelled in their entirety, and for such other and further relief as the Trademark Trial and Appeal Board may deem just and proper.

The filing fees required by 37 C.F.R. 2.6(a)(16) for filing this Petition to Cancel on behalf of Petitioner against both registrations are enclosed herewith.



NELSON MULLINS RILEY & SCARBOROUGH, L.L.P.

By: 

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(843) 720-4302

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Columbia, SC 29201  
(803) 799-2000

Attorneys for the Medical University of South Carolina

Charleston, South Carolina  
September 30, 2016

**CERTIFICATE OF SERVICE**

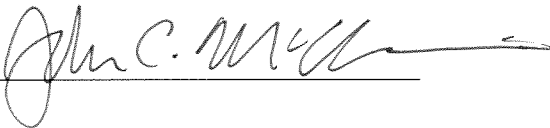
I hereby certify that a true and complete copy of the foregoing PETITION TO CANCEL has been served on the Registrant, by mailing said copy on the date indicated below, via First Class Mail, postage prepaid to the current correspondence address as listed in the Trademark Status and Document Retrieval (TSDR) system for U.S. Registration No. 4633651 and U.S. Registration No. 4735990, which current correspondence address are all listed as:

University of Utah  
2000 Circle of Hope  
Salt Lake City, Utah 84112.

with a courtesy copy mailed by First Class Mail, postage prepaid to:

Randall B. Bateman  
Snow Christensen & Martineau  
10 Exchange Place, 11th Floor  
Salt Lake City, UT 84111

Dated: September 30, 2016

  
\_\_\_\_\_

## Exhibit A

1. The Post Registration "Maintenance Tab" has been temporarily disabled. It will return soon.

2. The Trademark organization is beta testing a next generation examination system. As a result, there may be instances where Office actions have unexpected formatting or spacing issues. The Office is working on improvements to resolve these issues and appreciates your patience. Please contact us at [TMFeedback](#)

STATUS DOCUMENTS

[Back to Search](#)

Print

Generated on: This page was generated by TSDR on 2016-09-30 14:01:57 EDT

Mark: IMAGINE WHAT'S POSSIBLE

IMAGINE WHAT'S POSSIBLE

US Serial Number: 86645106

Application Filing Date: May 29, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: A final Office action refusing registration has been sent (issued) because the applicant neither satisfied nor overcame all requirements and/or refusals previously raised. The applicant may respond by filing (1) a request for reconsideration; and/or (2) an appeal to the Trademark Trial and Appeal Board. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Mar. 30, 2016

## Mark Information

Mark Literal Elements: IMAGINE WHAT'S POSSIBLE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

## Goods and Services

### Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

For: Charitable fundraising services

International Class(es): 036 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(b)

## Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: Yes

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

## Current Owner(s) Information

Owner Name: Medical University of South Carolina

Owner Address: 135 Cannon Street, Suite 402  
Charleston, SOUTH CAROLINA UNITED STATES 29425

Legal Entity Type: STATE AGENCY

SOUTH CAROLINA

State or Country Where  
Organized:

**Attorney/Correspondence Information****Attorney of Record**

Attorney Name: John C. McElwaine


Docket Number: 05986/09015


Attorney Primary Email Address: [jp@nelsonmullins.com](mailto:jp@nelsonmullins.com)

Attorney Email Authorized: Yes

**Correspondent**

Correspondent Name/Address: JOHN C. MCELWAINE  
Nelson Mullins Riley & Scarborough LLP  
100 N Tryon St  
Charlotte, NORTH CAROLINA UNITED STATES 28202-4000

Phone: 843-720-4302 

Fax: 834-534-4269 

Correspondent e-mail: [jp@nelsonmullins.com](mailto:jp@nelsonmullins.com)

Correspondent e-mail Authorized: Yes

[john.mcelwaine@nelsonmullins.com](mailto:john.mcelwaine@nelsonmullins.com)

Domestic Representative - Not Found

**Prosecution History**

Date	Description	Proceeding Number
Mar. 30, 2016	NOTIFICATION OF FINAL REFUSAL EMAILED	
Mar. 30, 2016	FINAL REFUSAL E-MAILED	
Mar. 30, 2016	FINAL REFUSAL WRITTEN	68365
Mar. 15, 2016	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 15, 2016	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 15, 2016	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 15, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Sep. 15, 2015	NON-FINAL ACTION E-MAILED	6325
Sep. 15, 2015	NON-FINAL ACTION WRITTEN	68365
Sep. 10, 2015	ASSIGNED TO EXAMINER	68365
Jun. 04, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 02, 2015	NEW APPLICATION ENTERED IN TRAM	

**TM Staff and Location Information****TM Staff Information**

TM Attorney: KING, CHRISTINA B

Law Office Assigned: LAW OFFICE 109

**File Location**

Current Location: TMEG LAW OFFICE 109 - EXAMINING ATTORNEY  
ASSIGNED

Date in Location: Mar. 30, 2016

**Assignment Abstract Of Title Information - Click to Load**

**Proceedings - Click to Load**

## Trademark/Service Mark Application, Principal Register

Serial Number: 86645106

Filing Date: 05/29/2015

### To the Commissioner for Trademarks:

**MARK:** IMAGINE WHAT'S POSSIBLE (Standard Characters, see mark)

The literal element of the mark consists of IMAGINE WHAT'S POSSIBLE.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Medical University of South Carolina, a state agency organized under the laws of South Carolina, having an address of  
135 Cannon Street, Suite 402  
Charleston, South Carolina 29425  
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 036: Charitable fundraising services.

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

### The applicant's current Attorney Information:

John C. McElwaine and Mark C. Dukes, Craig N. Killen, Charles G. Zug of Nelson Mullins Riley & Scarborough LLP

42nd Floor, IP Department  
100 North Tryon Street  
Charlotte, North Carolina 28202  
United States

The attorney docket/reference number is 05986/09015.

### The applicant's current Correspondence Information:

John C. McElwaine  
Nelson Mullins Riley & Scarborough LLP  
42nd Floor, IP Department  
100 North Tryon Street  
Charlotte, North Carolina 28202  
843-720-4302(phone)  
834-534-4269(fax)

ip@nelsonmullins.com;john.mcelwaine@nelsonmullins.com (authorized)

**E-mail Authorization:** I authorize the USPTO to send e-mail correspondence concerning the application to the applicant or applicant's attorney at the e-mail address provided above. I understand that a valid e-mail address must be maintained and that the applicant or the applicant's attorney must file the relevant subsequent application-related submissions via the Trademark Electronic Application System (TEAS). Failure to do so will result in an additional processing fee of \$50 per international class of goods/services.

A fee payment in the amount of \$275 has been submitted with the application, representing payment for 1 class(es).

### Declaration

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the

applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

**Declaration Signature**

Signature: /Christine W. Murray/ Date: 05/29/2015

Signatory's Name: Christine W. Murray

Signatory's Position: Director, MUSC Business Development and Marketing Services

RAM Sale Number: 86645106

RAM Accounting Date: 05/29/2015

Serial Number: 86645106

Internet Transmission Date: Fri May 29 10:31:12 EDT 2015

TEAS Stamp: USPTO/BAS-XX.XXX.XX.XX-20150529103112872

458-86645106-5301cc54d7d1af34ef5b4326b41

decd5cee98188a8bbbc922b9c6cc72cd3ff-DA-8

075-20150520133814232255

IMAGINE WHAT'S POSSIBLE



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**To:** Medical University of South Carolina ([ip@nelsonmullins.com](mailto:ip@nelsonmullins.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 86645106 - IMAGINE WHAT'S POSSIBLE - 05986/09015  
**Sent:** 3/30/2016 9:23:18 PM  
**Sent As:** ECOM109@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
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[Attachment - 18](#)  
[Attachment - 19](#)

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**  
**OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86645106

MARK: IMAGINE WHAT'S POSSIBLE

\*86645106\*

**CORRESPONDENT ADDRESS:**

JOHN C. MCELWAINE

Nelson Mullins Riley & Scarborough Llp

100 N Tryon St

Charlotte, NC 28202-4000

**CLICK HERE TO RESPOND TO THIS LETTER:**

[http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp)

[VIEW YOUR APPLICATION FILE](#)

**APPLICANT:** Medical University of South Carolina

**CORRESPONDENT'S REFERENCE/DOCKET NO :**

05986/09015

**CORRESPONDENT E-MAIL ADDRESS:**

ip@nelsonmullins.com

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE: 3/30/2016**

**THIS IS A FINAL ACTION.**

This Office action is in response to applicant's communication filed on March 15, 2016.

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration Nos. 4633651 and 4735990. See 15 U.S.C. §1052(d); 37 C.F.R. §2.63(b).

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods and/or services. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 (TTAB 2015) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

**SIMILARITY OF THE MARKS**

The applicant's mark is **IMAGINE WHAT'S POSSIBLE** for charitable fundraising services.

The registered marks are **IMAGINING WHAT'S POSSIBLE** and **WHAT'S POSSIBLE** for charitable fundraising services for cancer research and treatment.

"WHAT'S POSSIBLE" is common to applicant's mark and the cited marks. "IMAGINING" and "IMAGINE" are words that create the

same commercial impression and have the same meaning. See the attached dictionary definition. Imagining is defined as to form a mental image of (something not present). Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

Adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b). In this case, the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services is likely to result because the recollection of the average purchaser will be IMAGINE[ING] WHAT'S POSSIBLE or WHAT'S POSSIBLE.

Thus, the marks are confusingly similar.

#### RELATEDNESS OF THE SERVICES

The services are related. Both applicant and registrant use the marks in connection with charitable fundraising services. Absent restrictions in an application and/or registration, the identified services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

The services in this application are identified as “charitable fundraising services.” The services in the registration are identified as “charitable fundraising services for cancer research and treatment.” In this case, the identification set forth in the application has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrant’s more narrow identification.

Attached is an excerpt from the applicant’s website that shows that applicant is running a campaign for the Medical University of South Carolina’s Jenkin’s Children’s Hospital and features a cancer survivor. In conclusion, the marks are confusingly similar due to the similarity of the marks and the similarity and nature of the services.

Applicant argues that because it has a registration for the mark CHANGING WHAT’S POSSIBLE in classes 41, 42 and 44 for educational services, namely, providing courses of instruction and training at the undergraduate, graduate and professional level in the fields of medicine, nursing, health sciences, biomedical sciences, dental medicine, health administration, rehabilitation sciences, physical therapy, biochemistry, molecular biology, pharmaceutical sciences, pharmacology, environmental health sciences, marine biosciences, microbiology, immunology, biometry, epidemiology, and medical humanities; medical and pharmaceutical research; medical and scientific research, namely, conducting clinical trials; and health care services, namely, hospitals, emergency care centers, primary and specialty care centers, and outpatient clinics that was registered in 2010 that it is “wholly inconsistent for its application for IMAGINE WHAT’S POSSIBLE to be denied.”

Applicant further refers to and attaches an office action response for one of the cited registrations. Applicant seems to think because "WHAT'S POSSIBLE" was registered for charitable fundraising services for cancer research and treatment when the mark "BE WHAT'S POSSIBLE" was registered for charitable foundation services, namely, providing financial assistance for programs and services of others and charitable services, namely, organizing and conducting volunteer programs and community service projects that its mark should now register.

The facts in each case must be considered on a case by case basis. In this case applicant's mark IMAGINE WHAT'S POSSIBLE for charitable fundraising services is confusing similar to the registrant's marks IMAGINING WHAT'S POSSIBLE and WHAT'S POSSIBLE for charitable fundraising services for cancer research and treatment. And both marks are used in connection with the same services. Furthermore, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

Accordingly, the refusal to register is made final.

#### RESPONSE GUIDELINES FOR FINAL REFUSAL

Applicant must respond within six months of the date of issuance of this final Office action or the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond by providing one or both of the following:

- (1) A response that fully satisfies all outstanding requirements and/or resolves all outstanding refusals.
- (2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of \$100 per class.

37 C.F.R. §2.63(b)(1)-(2); TMEP §714.04; see 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. TMEP §714.04; see 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

**TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE:** Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$50 per international class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone without incurring this additional fee.

/Chrisie Brightmire King/

Trademark Attorney

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**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/mailling date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

## Exhibit B

1. The Post Registration "Maintenance Tab" has been temporarily disabled. It will return soon.

2. The Trademark organization is beta testing a next generation examination system. As a result, there may be instances where Office actions have unexpected formatting or spacing issues. The Office is working on improvements to resolve these issues and appreciates your patience. Please contact us at [TMFeedback](#)

## STATUS DOCUMENTS

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Mark: CHANGING WHAT'S POSSIBLE

CHANGING WHAT'S POSSIBLE

US Serial Number: 85020241

Application Filing Date: Apr. 22, 2010

US Registration Number: 4003495

Registration Date: Jul. 26, 2011

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jul. 26, 2011

Publication Date: Sep. 21, 2010

Notice of Allowance Date: Mar. 22, 2011

## Mark Information

Mark Literal Elements: CHANGING WHAT'S POSSIBLE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

## Goods and Services

### Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

For: Educational services, namely, providing courses of instruction and training at the undergraduate, graduate and professional level in the fields of medicine, nursing, health sciences, biomedical sciences, dental medicine, health administration, rehabilitation sciences, physical therapy, biochemistry, molecular biology, pharmaceutical sciences, pharmacology, environmental health sciences, marine biosciences, microbiology, immunology, biometry, epidemiology, and medical humanities

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 16, 2010

Use in Commerce: Aug. 16, 2010

For: Medical and pharmaceutical research; medical and scientific research, namely, conducting clinical trials

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 16, 2010

Use in Commerce: Aug. 16, 2010

For: Health care services, namely, hospitals, emergency care centers, primary and specialty care centers, and outpatient clinics

International Class(es): 044 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 16, 2010

Use in Commerce: Aug. 16, 2010

**Basis Information (Case Level)**

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

**Current Owner(s) Information**

Owner Name: Medical University of South Carolina

Owner Address: 135 Cannon Street, Suite 402  
Charleston, SOUTH CAROLINA UNITED STATES 29425

Legal Entity Type: STATE AGENCY

State or Country Where Organized: SOUTH CAROLINA

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Correspondent e-mail Authorized: No

Domestic Representative - Not Found

**Prosecution History**

Date	Description	Proceeding Number
Jul. 26, 2011	REGISTERED-PRINCIPAL REGISTER	
Jun. 21, 2011	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Jun. 20, 2011	LAW OFFICE REGISTRATION REVIEW COMPLETED	70884
Jun. 17, 2011	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jun. 04, 2011	TEAS/EMAIL CORRESPONDENCE ENTERED	70884
Jun. 04, 2011	CORRESPONDENCE RECEIVED IN LAW OFFICE	70884
May 26, 2011	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 18, 2011	NOTIFICATION OF NON-FINAL ACTION E-MAILED	
May 18, 2011	NON-FINAL ACTION E-MAILED	
May 18, 2011	SU - NON-FINAL ACTION - WRITTEN	81112
May 13, 2011	STATEMENT OF USE PROCESSING COMPLETE	66530
May 09, 2011	USE AMENDMENT FILED	66530
May 12, 2011	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66530
May 09, 2011	TEAS STATEMENT OF USE RECEIVED	
Mar. 22, 2011	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Feb. 04, 2011	EXTENSION OF TIME TO OPPOSE PROCESS - TERMINATED	
Oct. 07, 2010	EXTENSION OF TIME TO OPPOSE RECEIVED	
Sep. 21, 2010	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Sep. 21, 2010	PUBLISHED FOR OPPOSITION	
Aug. 19, 2010	LAW OFFICE PUBLICATION REVIEW COMPLETED	70884
Aug. 19, 2010	ASSIGNED TO LIE	70884



Aug. 03, 2010	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 02, 2010	ASSIGNED TO EXAMINER	81112
Apr. 28, 2010	NOTICE OF PSEUDO MARK MAILED	
Apr. 27, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 26, 2010	NEW APPLICATION ENTERED IN TRAM	

**TM Staff and Location Information**

TM Staff Information - None

**File Location**

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jun. 20, 2011

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